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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,943	11/20/2003	Bodo Homann	028987.52713US	6800

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EXAMINER
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PEDDER, DENNIS H

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/716,943

**Applicant(s)**

HOMANN ET AL.

**Examiner**

Dennis H. Pedder

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/03 &amp; 9/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20, 22, 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague in reciting both a motor vehicle and a passenger car of the sports car type. Claim 1 is also vague in “essentially meeting only at edge zones of the roof”. It either does so meet or it doesn’t so meet.

Claims 22 and 25 are vague in “relatively thin-walled”. There is no frame of reference for this term and no support as filed to elucidate.

Claim 26 is clearly erroneous in its dependency as claim 1 is not a method claim.

### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plastic material in appropriate cross sectional indication must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

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should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-5, 17-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porsche in view of Kanou.

Porsche has the removable roof 7 of plastic material (page 3, lines 63-76), roll bar 6, windshield frame 2, and has partial interior walls at 17 and at rear, leaving the central portion of the roof single panel.

Kanou teaches that a removable roof may be constructed of dual panels 8 and 9, the panels meeting at edge regions only. As a result of this prior art reference, it would have been obvious to one of ordinary skill to provide in Porsche a dual panel edge joined roof as taught by Kanou in order to strengthen the assembly.

As to claims 2-3, this material and adhesive bonding of panels are common knowledge in this art, obvious to use here as a light weight and strong material and as an extremely strong bond.

Applicant may seasonally challenge, for the official record in this application, this and any other statement of judicial notice in timely manner in response to this office action. Please specify the exact statement to be challenged. Applicant is reminded, with respect to the specific challenge put forth, of the duty of disclosure under Rule 56 to disclose material which is pertinent to patentability including claim rejections challenged by applicant.

As to claim 4, the walls define a narrow space therebetween across their entire extent.

As to claim 5, all three dimensional structure has a profile.

As to claims 17-20, these features are of common knowledge in the art and not indicative of patentability.

7. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porsche in view of Kanou as applied to claim 5 above, and further in view of Perks.

It would have been obvious to one of ordinary skill to provide in the references above a recessed U-shaped mounting in the roof inner panel in order to accommodate a roof locking device as taught by Perks. Motivation is self-evident. Such recessed mounting reduces chance of injury.

8. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porsche in view of Kanou and Perks as applied to claim 6 above, and further in view of Chrysler, US Re. 32,496.

It would have been obvious to one of ordinary skill to provide in the references above a U-shaped cross section receiving a window seal as taught by Chrysler at 34, figure 8 in order to seal the interior environment.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porsche in view of Kanou, Perks, and Chrysler as applied to claim 10 above, and further in view of Steyer-Daimler-Puch AG .

It would have been obvious to one of ordinary skill to provide in the references above dual roof elements as taught by Steyer-Daimler-Puch AG in order to reduce the weight during removal of the roof.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porsche, Kanou, Perks, Chrysler, and Steyer-Daimler-Puch AG as applied to claim 12 above, and further in view of Farber.

Prior to the invention of applicant, Farber taught that the juncture of two roof elements could be sealed by means of a channel member 26 carried by one of the roof elements and comprising a sixth profiling rotated 90 degrees and open toward the other profiling

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and carrying another sealing body 25, as well as a drain channel 70. As a result, It would have been obvious to one of ordinary skill to provide in the references above a seal structure as taught by Farber in order to dispose of inadvertent leakage past the primary seal of two roof elements.

***Allowable Subject Matter***

11. Claims 14-16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

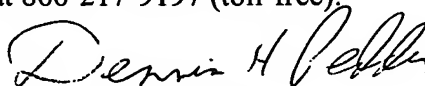
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Henderson and Hulls teach plastic roof elements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis H. Pedder whose telephone number is (703) 308-2178. The examiner can normally be reached on 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on (703) 308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dennis H. Pedder  
Primary Examiner  
Art Unit 3612

10/8/04

DHP  
10/7/2004